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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,921	01/15/2002	Andrew Lewis Schirmer	23452-508	4465

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PILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

NGUYEN, CAM LINH T

ART UNIT PAPER NUMBER

2161

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/044,921

Applicant(s)

SCHIRMER ET AL.

Examiner

CamLinh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments to the Specification are acknowledged. Consequently, objection to the Specification is withdrawn.
2. Applicant's amendments to claims 1 - 33 are acknowledged. Consequently, claims 1 - 2, 11 - 12, and 21 - 22 have been amended, claims 32 - 33 are newly added. Claims 1 - 33 are currently pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 - 10, 32 - 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, although claims 1 - 10, and 32 - 33 recite an abstract idea of a method for mining documents associated with a user to determine the user's affinities, however, the language of the claims raise a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

5. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of

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application amending these claims to place them within the four statutory categories of invention.

***Claim Objections***

6. Claims 1, 11, and 21 recite the limitation "the corresponding category". There is insufficient antecedent basis for this limitation in the claim. The Examiner is not sure which category applicant refers to (master, user or filter user category). Correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilmour et al (U.S. 6,115,709).

♦ As per claims 1, 11, 21, 31, 32,

Gilmour discloses a method and system for mining e-mails to determine a user's affinities comprising:

- Means (Fig. 1, element 23) for "Accessing an e-mail system and retrieving from the system the e-mails sent to and from the user" See Fig. 1 - 2. "E-mail system" corresponds to the "e-mail server" 23, col. 7, lines 3 – 9, col. 5, lines 25 – 30. "Retrieving from the system the e-mails sent to and from the user" See col. 14, lines 38 – 40.

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- Means (Fig. 2, element 47) for “Extracting keywords from the retrieved e-mails” See col. 8, lines 42 – 48, and Fig. 8, element 164, col. 14, lines 22 – 38.
  - Means (Fig. 2, element 45 - 46) for “Generating a list of categories based on the extracted keywords” Gilmour teaches that “term” includes any acronym, collection of words (col. 6, lines 36 – 38). The terms if form in a relevant knowledge terms for the purpose of grouping, ranking (col. 5, lines 6 – 8). Therefore, term in the Gilmour reference corresponds to a category. The “extracting terms” corresponds to “a list of categories”.
  - Means (Fig. 1, element 50) for “Accessing a master category list” the “master category list” corresponds to the “user knowledge profile” (Fig. 17A, element 308, col. 4, lines 66 – 67, col. 5, lines 41 - 45).
  - Means (Fig. 2, element 45 - 46) for “Filtering the generated category list by removing from the generated list those categories that are not included in the master category list” See col. 9, lines 1 – 20, and also col. 18, lines 59 – 66.
  - Means (Fig. 2, element 45 - 46) for “ For each category remaining in the generated category list, calculating an affinity value and associating the affinity value with the category, wherein the affinity value represent the strength of the user's relationship to the category” See Fig. 8, element 154, col. 14, lines 59 – 67, Fig. 9A-B. “The affinity value” corresponds to the “confidence value” in Fig. 9, col. 16, lines 34 – 36.
- ◆ As per claims 2 - 3, 12 – 13, 22 – 23, Gilmour discloses:
- “Submitting a proposed user affinity for publication, wherein the proposed user affinity includes one of the categories from the generated category list and the affinity value associated with the category” See Fig. 15A, col. 18, lines 19 – 22.

- “Determining an affinity value threshold” See Fig. 15A, col. 18, lines 10 – 14.
- ◆ As per claims 4 - 6, 14 – 16, 24 – 26, Gilmour discloses:
  - “Determining whether the affinity value included in the proposed user affinity exceeds the affinity value threshold” col. 18, lines 22 – 34.
  - “If the affinity value included in the proposed user affinity does not exceed the affinity value threshold, then the proposed user affinity is not published” and “publishing the proposed user affinity if it is determined that the affinity value included in the proposed user affinity exceeds the affinity value threshold” See Fig. 15A, col. 18, lines 22 – 34.
- ◆ As per claims 7 - 8, 17 – 18, 27 – 28, Gilmour discloses:
  - “Notifying the user of the proposed user affinity and requesting from the user a response that indicates whether or not the user wishes to have the proposed user affinity published if it is determined that the affinity value included in the proposed user affinity exceeds the affinity value threshold” See Fig. 15B, col. 19, lines 26 – 30.
- ◆ As per claims 9, 19, 29, Gilmour discloses:
  - “Receiving the response from the user; determining whether the response indicates that the user wishes to have the proposed user affinity published; and publishing the proposed user affinity if it is determined that the response indicates that the user wishes to have the proposed user affinity published” col. 19, lines 36 – 38, fig. 16B, col.41 – 53.
- ◆ As per claims 10, 20, 30, 33, Gilmour discloses:
  - “The step of publishing the proposed user affinity comprises the step of updating a profile associated with the user such that the profile indicates that the user has an affinity for the category included in the proposed user affinity” See Fig. 17D – E, col. 21, lines 29 – 33.

***Response to Arguments***

9. Applicant's arguments filed 12/01/2004 have been fully considered but they are not persuasive.

Applicant's amendments to claims 1 – 33 raised new errors that need to correct and verify.

Therefore, the Gilmour reference still applies to the instant application.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272-4024. The examiner can normally be reached on Monday-Friday.

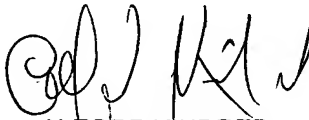


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**ALFORD KINDRED**  
**PRIMARY EXAMINER**